



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,221	03/16/2001	Edward G. Tiedemann JR.	PA579C1	3117
23696	7590	08/23/2005	EXAMINER SAM, PHIRIN	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ART UNIT 2661	PAPER NUMBER

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/811,221	Applicant(s) TIEDEMANN, EDWARD G.	
	Examiner Phirin Sam	Art Unit 2661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

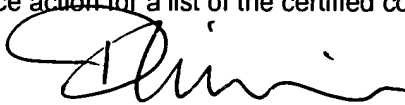
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


PHIRIN SAM

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 22, 23, 25, and 26 are rejected under the judicially created doctrine of double patenting over claim 1 of U. S. Patent No. 6,542,488 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application's claims 22 and 25 merely broaden the scope of claim 1 of U.S. application No. 6,542,488 by eliminating "(B) receiving the plurality of power control bits at the mobile station; and (C) transmitting a message from the first mobile station ... to the first access channel and the first time offset". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. *In re Karlson*, 36 USPQ 184 (CCPA). Also note *Ex parte Rainu*, 168 USPQ 375 (Bd. App. 1969); Omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claims 23 and 26, the instant application claims merely broaden the scope of claim 1 of U.S. application No. 6,275,478 by eliminating “(A) transmitting a power control information packet ... has a position that is” and “(C) transmitting a message from the first mobile station ... to the first access channel and the first time offset”. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

3. Claims 22, 23, 25, and 26 are rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Pub. No. 2001/0028638 since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application's claims 22 and 25 merely broaden the scope of claim 1 of U.S. Pub No. 2001/0028638 by eliminating “transmitting a message from the mobile station ... within the access channel”. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); Omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claims 23 and 26, the instant application claims merely broaden the scope of claim 1 of U.S. Pub. No. 2001/0028638 by eliminating “transmitting a plurality of power control bits from a base station; transmitting a message from the mobile station ... within the access

Art Unit: 2661

channel". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

4. Claims 22, 23, 25, and 26 are rejected under the judicially created doctrine of double patenting over claim 1 of U.S. Patent No. (6,542,488) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application's claims 22 and 25 merely broaden the scope of claim 1 of U.S. Pub No. 2001/0028638 by eliminating "receiving the plurality of power control bits at the mobile station". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); Omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claims 23 and 26, the instant application claims merely broaden the scope of claim 1 of U.S. Patent No. (6,542,488) by eliminating "transmitting a plurality of power control bits in a power control information packet from the base station". It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

Regarding claims 22, 23, 25, and 26, the subject matter claimed in the instant application is fully disclosed in claims of the US Patents above. Therefore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application, which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,590,409 (hereinafter referred as "Sawahashi") in view of US Patent 5,909,436 (hereinafter referred as "Engstrom").

Sawahashi discloses the invention (**claims 22-27**) as claimed including a method for controlling transmission of signals from one or more mobile stations, the method comprising:

- (a) transmitting a power control information packet formed from a plurality of power control bits from a base station to one or more mobile stations (see Figs. 4 and 5, col. 6, lines 3-7, col. 7, lines 9-12);
- (b) mapping a position of each of the power control bits in the power control information packet (see Figs. 4 and 5, col. 7, lines 12-15).

Sawahashi does not disclose a selected access channel of a plurality of access channels and to a time offset within the selected access channel. However, Engstrom discloses the selected access

Art Unit: 2661

channel of the plurality of access channels and to the time offset within the selected access channel (see Figs. 3-5, col. 6, lines 58-64, col. 7, lines 50-67). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the selected access channel and the time offset teaching by Engstrom with Sawahashi. The motivation for doing so would have been to provide to adjust the mobile station's timing advance in accordance with the transmission read on column 3, lines 11-15. Therefore, it would have been obvious to combine Engstrom and Sawahashi to obtain the invention as specified in the claims 22-27.

Response to Arguments

7. In order to response properly to the new claims 22-27, the Examiner drops the reference US Patent 5,896,411 (Ali et al) and substitutes with US Patent 5,590,409 (hereinafter referred as "Sawahashi") and US Patent 5,909,436 (hereinafter referred as "Engstrom") which are new discovered references. Therefore, new ground of rejections are applied as set forth in the Office Action above.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on Mon-Fri, 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T. Nguyen can be reached on (571) 272 - 3126. The fax number for the organization where this application or proceeding is assigned is (571) 273 - 8300.

Art Unit: 2661

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully submitted,

Date: August 20, 2005



PHIRIN SAM
PRIMARY EXAMINER